

**REMARKS/ARGUMENTS**

In the recent office action, the Examiner objected to the Abstract because it was not in the form of a single paragraph. The Abstract has been amended, and has been placed in single paragraph form.

Applicant appreciates the courtesies extended by Examiner Drodge to Applicant's representative during the personal interview held June 1, 2005. The present response summarizes the substance of the interview. At the interview, a proposed amendment was presented and a model of Applicant's invention was demonstrated. Proposed Claim 1 set forth further limitations to more clearly define Applicant's filter insert over the cited prior art. Arguments were advanced that the prior art does not teach or suggest Applicant's filter insert, nor the combination of filter element and rain gutter as defined in the claims of the proposed amendment. The Examiner indicated a concern that the Dugan patent (US 3,855,132) suggested applicant's filter element. The Examiner did indicate that Applicant's claims drawn to the combination filter and rain gutter may be patentable over the prior art of record. However, no agreement was reached, and no indication of allowability was given. The Examiner also stated that a further search may be conducted.

With this in mind, Applicant has amended the present application by canceling original Claims 1 through 11, and has replaced them with newly added Claims 12-20.

Claim 12, which is now the only independent claim, corresponds to original dependent claim 5 written in independent form and made to include all the limitations of the parent claim. New Claim 12 and all of its dependent claims are now drawn to the filter insert and rain gutter combination, previously recited in original claims 5-11.

In the recent Office Action the Examiner rejected Claims 1, 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Dugan (U.S. 3,855,132) in view of Silva (U.S. 5,536,406).

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dugan (U.S. 3,855,132) in view of Silva (U.S. 5,536,406) for the same reasons as the rejection of Claim 2, and further in view of Etani (U.S. 3,947,362).

Claims 5 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dugan (U.S. 3,855,132) in view of Silva (U.S. 5,536,406) for the same reasons as the rejection of Claim 1, and further in view of Allen (U.S. 5,522,183).

Claims 7 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dugan (U.S. 3,855,132) in view of Silva (U.S. 5,536,406) and Allen (U.S. 5,522,183) for the same reasons as the rejection of Claim 5, and further in view of Hunt (U.S. 5,103,601).

Claims 6, 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dugan (U.S. 3,855,132) in view of Silva (U.S. 5,536,406) and Etani (U.S. 3,947,362) for the same reasons as the rejection of Claim 3, and further in view of Allen (U.S. 5,522,183).

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

MPEP § 2143 states: “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

With this as background, the Examiner's rejections of Applicant's Claims to a combination filter insert and rain gutter are discussed. The Examiner's rejection of claim 5 (corresponding to new Claim 12) is a combination of three references, Dugan in view of Silva and Allen. The patent to Dugan shows an open trough filler 2 made of porous polyurethane foam material, for placement in a rain gutter 1. The filler 2 extends from front to back of the gutter 1, and a space or open passageway 8 is left between the bottom of the filler 2 and the bottom of the gutter 5. This open passageway configuration may be formed by forming a slot in the lower portion of the filler, or by providing spaced supports along the length of the gutter bottom 5 to support the filler and maintain the open passageway. Dugan does not show the particular shape of Applicant's filter insert, or the particular orientation of the filter insert in the rain gutter. In particular, Dugan fails to show an elongated filter element having a cross section in the general form of a right triangle having a generally horizontal upper side with front and rear edges, a generally vertical rear side perpendicular to the upper side, and an angled side extending between the front edge of said upper side and extending to a lower point forward of the lower edge of the rear side and rearward of the upper side front edge, and a lower side parallel with said upper side, the lower side being formed by the truncation of said generally triangular filter element between the rear side and the angled side. Nor, does Dugan show a generally right triangular filter inserted in a rain gutter wherein the upper side of the insert spans the upper opening in the rain gutter, the rear side bears against the back wall

of the rain gutter, the lower side of the insert bears against the gutter bottom wall, and an angled side of the insert extends between the lower side and the upper side, thereby defining a void between said angled side, the front wall and the bottom wall of the rain gutter.

Recognizing these deficiencies in Dugan, the Examiner turns to the teachings of Silva and Allen. Silva shows a drain filtering device that is placed at the end of a rain gutter at the down spout. The device 18 has an upwardly inclined upper face 12. Debris that collects in the gutter is carried along with the water until it makes contact with the inclined upper face and is forced up the incline until the debris overflows the side of the gutter. Silva is not an elongated filter element, and it does not show the proper right triangular cross-sectional shape of Applicant's invention, with the angled wall sloping back towards the lower edge of the rear wall, rather than away from it. Allen shows a gutter screen 22 that has a moveable leg 28, the outside face of the leg 28 facing the bottom and rear walls of the gutter 12 forming a void between said angled leg 28 and the bottom and rear walls of the gutter. It is important to note that the angled side of Applicant's filter insert faces the bottom and front walls of the gutter, unlike the angled leg 28 of Allen which faces the bottom and rear walls of the gutter when inserted therein.

The Examiner believes that it would have been obvious to one of ordinary skill in the art to modify the filter element of Dugan, in view of the teachings of Silva, to provide the particular cross-sectional shape recited in Applicant's claims, and to orient the modified filter in a rain gutter, in accordance with the teachings of Allen, in such a manner that a void is formed between the angled side of the filter and the front and bottom walls of the rain gutter. Applicant does not agree. Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). There is nothing in the teachings of the relied upon prior art references which would have suggested the desirability, and thus the obviousness of the Examiner's modifications of the open trough filler in Dugan. Indeed, some of the modifications are not even shown in the teaching references (e.g. the angled side of the filter facing the bottom and front walls of the gutter). It is only by impermissible hindsight and reliance on Applicant's own disclosure that the Examiner would have been led to reconstruct the trough filler of Dugan so as to derive Applicant's claimed filter insert and gutter combination from the applied teachings. It is therefore Applicant's conclusion that the combined teachings of Dugan, Silva and Allen fail to establish a *prima facie* case of obviousness.

The Etani patent and the Hunt patent, relied upon by the Examiner in rejecting dependent claims, have also been carefully reviewed, however, Applicant finds nothing therein which would overcome or supply that which is lacking in the basic combination of the other applied prior art noted above.

The claims in this application have been revised to more particularly define applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the above-noted reasons is respectfully requested.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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